

Appln No. 09/966,572
Amdt date November 8, 2004
Reply to Office action of August 6, 2004

REMARKS/ARGUMENTS

Claims 1-4, 7-10, 13-16, 19, 20, and 22-28 remain in this application, claims 6, 11, 17 and 18 having been canceled. In the Office action dated August 6, 2004, the examiner rejected all claims under 35 U.S.C. 112, for failing to comply with the written description. The claims previously recited "metalloid oxide layers formed on the core" and the inclusion of "non-lithiated metal." Applicant has amended independent claims 1, 7, 13, 23 and 26 to include the specific metals which form oxides, and to remove any reference to "non-lithiated" oxides. Dependent claims 6, 11 and 17 have correspondingly been canceled. Applicant is of the opinion that the rejection under Section 112 has been overcome.

Claims 1-4 and 6-11 have been rejected under Section 103(a) based on Amatucci. The examiner admits that Amatucci is silent as to the use of *two* oxide layers, but asserts that "it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ an additional metal oxide coating on the lithiated compound." The examiner cites *In re McLaughlin*, 443 F.2d 1392, 1395, 170 U.S.P.Q. 209, 212 (CCPA 1971) for the position that a hindsight reconstruction is proper where "it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made." However, such an approach is only permissible where the assertion of obviousness "does not include knowledge gleaned only from applicant's disclosure." *Id.* Here, the *only* teaching as to the use of two different oxides is the application itself. Absent some *evidence* of obviousness outside the patent specification, the examiner's rejection of these claims is improper; the burden of *prima facie* obviousness can only be satisfied "by showing *some objective teaching in the prior art* or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F. 2d 1071, 1074, 5 U.S.P.Q. 2d 1496, 1598 (Fed. Cir. 1984) (emphasis added). Here, the examiner fails to provide any secondary reference or other teaching to arrive at the claimed invention. Furthermore, applicant has still further clarified independent claim 1 to recite that "at least two *different* oxide layers" are formed on the core. Similar amendments have been made to independent claim 7. Applicant submits that the cited art fails to teach or suggest such a

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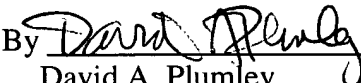
combination, and that claims 1-4 and 7-10 are allowable. Applicant requests reconsideration of this basis for rejection.

The examiner further rejects claims 1, 3, 4, 6-11, 13-20 and 22 as unpatentable under Section 103 based on Zhang et al. Once again, the examiner admits that Zhang et al. are silent as to providing two oxide layers on the core, but fails to set forth any *evidence* that would teach or suggest the missing elements. As pointed out above, independent claims 1 and 7 have been amended to recite that "*two different*" oxide layers are provided. Independent claim 13 has been amended similarly. Consequently, as set forth above, the examiner has failed to establish a *prima facie* case of obviousness, and the claims are allowable.

Finally, the examiner has rejected claims 23-28 under Section 103 based on Zhang et al. in view of Amatucci. Independent claims 23 and 26 have been amended to clarify that *two different* oxide layers be formed over the core. As pointed out above, neither Zhan et al. nor Amatucci teach or suggest the use of two oxide layers and the examiner has failed to set forth any evidence of such a teaching. Because the examiner has failed to establish a *prima facie* case of obviousness, claims 23-28 are allowable.

Claims 1-4, 7-10, 13-16, 19, 20, and 22-28 remain in this application. For the reasons set forth above, all remaining claims are allowable over the cited art. Applicant requests issuance of a Notice of Allowance. However, if there are any remaining issues, the examiner is asked to contact applicant's counsel at the number below.

Respectfully submitted,
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